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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/436,704

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DANIEL R. BAUM

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31688

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08/26/2004

TRAN & ASSOCIATES
6768 MEADOW VISTA CT.
SAN JOSE, CA 95135

EXAMINER

BRINICH, STEPHEN M

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 08/26/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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Commissioner for Patents

Office Action Summary

Application No.

09/436,704

Applicant(s)

BAUM, DANIEL R.

Examiner

Stephen M Brinich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-155 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-155 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 5/27/04, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, & 154 are rejected under 35 U.S.C. 102(b) as being anticipated by Fredlund et al.

Re claims 1-2, 7-8, 12-13, 15-17, 30-33, 39-41, 43, 59-61, 64-65, 69, 80-81, 86-87, 91-92, 94-96, 107-110, 132-135, 143, 147-149, & 152, Fredlund et al discloses (Abstract; column 2, lines 28-42; column 5, lines 32-51; column 6, lines 30-42; column 7, lines 18-30) a computer-implemented method and print system in which a user may select a series of images to be photographically printed and respectively sent to a recipient address by a single entity (a photo processing station: see column 6, lines 17-42).

Further re claims 1-2, 7-8, 12-13, 15-17, 30-33, 39-41, 43, 59-61, 64-65, 69, 80-81, 86-87, 91-92, 94-96, 107-110, 132-135, 143, 147-149, & 152, while Fredlund et al describes the set of images selected to be sent to one recipient as an "order", a sequence in which one set of images is designated for printing and sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for printing and sending to a different recipient (and so on until all desired images and recipients are selected) is readable upon Applicant's use of the term "order specifying a plurality of recipients"

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(which would then consist of several "sub-orders", each being sent to a given recipient), inasmuch as the present claim language does not preclude the reading of such a multi-recipient session upon the term "order" as used in the present claims.

Further re claims 3-6, 22, 44, 48, 51, 57-58, 63, 82-85, 140, & 144-146, Fredlund et al discloses (column 7, lines 60-64) the computer-aided customization of image print parameters (including a text message) for individual images to be sent to respective recipients.

Further re claim 10, 67, 89, & 154, Fredlund et al discloses (Figure 3; column 5, lines 14-16) the provision of a front-end graphical user interface that is used to present information and collect user inputs to be remotely transmitted.

Further re claims 18-21, 71-74, 97-99, & 136-139, Fredlund et al discloses (column 8, lines 12-15) the printing of an address label (inherently including the recipient's name and address, as the absence of this information would make the "address label" fail in the purpose of indicating a destination address).

Further re claims 23-24, 45, 100-101, & 141-142, Fredlund et al discloses (column 7, lines 26-30) the production of an instant digital copy of an ordered image in the form of a Photo CD (a medium containing one or more digital image files).

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Further re claims 34 & 111, the specified recipient differs from the customer in any case in which the customer enters any address other than his own as a recipient address area 70 (column 6, lines 23-25).

Further re claims 35-38 & 112-115, the sequence in which one set of images is designated for sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for sending to a different recipient (and so on until all desired images and recipients are selected) comprises at least one charge (which is readable upon a recitation of "a single charge" unaccompanied by limitations precluding a plurality of charges) to a financial instrument (column 6, lines 30-41) such as a credit card (column 6, lines 45-46). The sequence is terminated (in the case where the user wishes to go ahead with the planned order) by pressing a "send" button to place the order (column 6, lines 53-54).

Further re claim 42, Fredlund et al discloses (column 7, lines 60-64) the printing of an image to be sent to a designated recipient in the form of a framed print.

Further re claims 46-47, Fredlund et al discloses (column 7, lines 49-51) the printing of an image upon a novelty item such as a customized coffee mug or T-shirt.

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Further re claims 49-50, Fredlund et al discloses (Figure 3) the printing of an image upon a card (3x5, 4x6, etc).

Further re claim 52, the text message of Fredlund et al (column 7, lines 60-64) is readable upon the recited "advertisement" in the case where the user enters an advertising statement as the selected text.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 9, 11, 14, 66, 68, 70, 88, 90, & 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Tackbarry et al.

Re claims 9, 11, 14, 66, 68, 70, 88, 90, & 93, Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra (i.e. by a single entity).

Fredlund et al does not disclose expressly the division of these steps among separate entities.

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Tackbarry et al discloses (column 12, line 55 - column 13, line 3) an order receiving, printing, and distribution process for picture prints in which the distribution process is carried out by an entity different from the entity that receives and prints orders.

Fredlund et al and Tackbarry et al are combinable because they are from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Tackbarry et al system of print distribution.

The suggestion/motivation for doing so would have been allow the use of established distribution channels (such as those taught by Tackbarry et al at column 9, lines 9-11).

Therefore, it would have been obvious to combine Fredlund et al with Tackbarry et al to obtain the invention as specified in claims 9, 11, 14, 66, 68, 70, 88, 90, & 93.

6. Claims 25-29, 75-79, 102-106, 116-126, 150-151, 153, & 155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Cok.

Re claims 25-27, 75-77, 102-104, 116-118, 121-126, 150-151, & 153, Fredlund et al discloses the order receiving, printing,

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and distributing process of picture prints as described in paragraph 3 supra.

Re claims 28, 78, 105, 119, & 151, Fredlund et al further discloses (column 3, lines 19-42) the provision of photo prints via a photo store, supermarket, or drugstore.

Re claims 29, 79, 106, 120, & 155, in the case in which a user purchases prints from such a provider and also orders other goods and services provided therefrom, the two will be distributed via the same channel.

Fredlund et al does not disclose expressly the receipt and dividing of an order by an entity different from the entity that performs the printing of the order.

Cok discloses (column 2, line 60 - column 3, line 7) the receiving and dividing of an order by one entity (a processor) and the printing of the order by a separate entity (a set of output systems) that provide the service of printing.

Fredlund et al and Cok are combinable because they are both from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Cok set of output systems.

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The suggestion/motivation for doing so would have been distribute the printout load in order to provide outputs of various desired formats (as described by Cok at column 3, lines 7-9).

Therefore, it would have been obvious to combine Fredlund et al with Cok to obtain the invention as specified in claims 25-29 & 75-79.

7. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Brewen.

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra.

Fredlund et al does not disclose expressly a picture print in the form of a coupon.

Brewen discloses (Figure 3) the production of a picture print in the form of a coupon.

Fredlund et al and Brewen are combinable because they are both from the field of digital image selection and printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Fredlund et al system of order receiving, printing, and distributing process of picture prints to print a picture whose content is that of the coupon disclosed by Brewen.

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The suggestion/motivation for doing so would have been to use a known system of order receiving, printing, and distributing process of picture prints to produce a specific type of desired image printout.

Therefore, it would have been obvious to combine Fredlund et al with Brewen to obtain the invention as specified in claim 53.

8. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Stancato.

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra.

Fredlund et al does not disclose expressly the binding of picture prints in the form of a bound volume such as an album or travel book.

Stancato discloses (column 1, lines 6-16) the production of a bound volume of picture prints (which inherently constitutes a "photo-album", and constitutes a "travel book" in the case where the user selects images for the purpose of documenting and illustrating travel).

Fredlund et al and Stancato are combinable because they are from the field of digital image selection and printing.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Fredlund et al system of order receiving, printing, and distributing process of picture prints to print pictures which are bound in the volume described by Stancato.

The suggestion/motivation for doing so would have been to use a known system of order receiving, printing, and distributing process of picture prints to produce a set of images that are bound for protection and convenient access.

Therefore, it would have been obvious to combine Fredlund et al with Stancato to obtain the invention as specified in claims 54-56.

9. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Klees et al.

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra.

Fredlund et al does not disclose expressly that the computer system used for order input is a public entry terminal.

Klees et al discloses (column 2, line 29 - column 3, line 4; particularly column 2, lines 53-57) the use of a publicly accessible terminal to enter a picture print order.

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Fredlund et al and Klees et al are combinable because they are both from the field of order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a publicly accessible terminal to accept orders into the Fredlund et al system of order receiving, printing, and distributing process of picture prints.

The suggestion/motivation for doing so would have been so that customers who do not possess individual personal computers may be served.

Therefore, it would have been obvious to combine Fredlund et al with Klees et al to obtain the invention as specified in claim 62.

10. Claims 127-131 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Klees et al as applied to claim 62 above, and further in view of Cok.

Re claims 127-131, Fredlund et al in view of Klees et al teaches the order receiving, printing, and distributing process of picture prints, with the order receiving implemented through a public terminal kiosk, as described in paragraph 9 supra.

Further re claims 128-129, Fredlund et al discloses (column 7, lines 26-30) the production of an instant digital copy of an

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ordered image in the form of a Photo CD (a computer-readable medium containing one or more digital image files).

Fredlund et al does not disclose expressly the receipt and dividing of an order by an entity different from the entity that performs the photo printing of the order.

Cok discloses (column 2, line 60 - column 3, line 7) the receiving and dividing of an order by one entity (a processor) and the printing of the order by a separate entity (a set of output systems) that provide the service of printing.

Fredlund et al and Cok are combinable because they are both from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Cok set of output systems.

The suggestion/motivation for doing so would have been distribute the printout load in order to provide outputs of various desired formats (as described by Cok at column 3, lines 7-9).

Therefore, it would have been obvious to combine Fredlund et al with Cok to obtain the invention as specified in claims 25-29 & 75-79.

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Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.


If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.

Stephen M Brinich
Examiner
Art Unit 2624

smb 
August 20, 2004




TOMMY LEE
PRIMARY EXAMINER